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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/612,782
Filing Date: July 01, 2003
Appellant(s): LIBBY ET AL.

Budd Libby et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 06, 2009 and supplemental appeal brief filed November 23, 2009 appealing from the Office action mailed January 07, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The brief identifies Scientific Games International, Inc, the assignee of right in the present application as the party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves rejected claims 20-28. Claims 1-19 were previously cancelled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

An amendment was entered in the supplemental brief filed 11/23/09 to correct dependency of claims 21-23.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(Note: The rejection statement in the Final Rejection dated July 7, 2009 and the Grounds of Rejection listed in item (9) below do not match. However, the rejection statement heading is corrected to match the instant rejection as applied in the body of the rejection in the Office Action dated July 7, 2009, which is acknowledged and acquiesced by the Appellant (appeal brief page 4 (status of claims)).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Malone	US 6,585,590 B2	July 1, 2003
Itkis et al.	US 2003/0171986 A1	September 11, 2003
Graves et al.	US 6,955,604 B1	October 18, 2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malone (US 6,585,590) in view of Itkis (US 2003/0171986) and in further view of Graves (US 6,955,604).

(Note: The rejection statement in the Final Rejection dated July 7, 2009 and the Grounds of Rejection listed above do not match. However, the rejection statement heading is corrected to match the instant rejection as applied in the body of the rejection in the Office Action dated July 7, 2009, which is acknowledged and acquiesced by the Appellant (appeal brief page 4 (status of claims)).

Claims 20-21 and 24-25: In regards to claims 20 and 24, Malone discloses a bingo system comprising a bingo game server which generates a bingo game linked to gaming terminals for providing bingo games. The server or bingo game generator implements the following steps:

(a) providing a plurality of unique game cards and enabling players to purchase the cards via remote game client computers/terminals, wherein at least one game is a winning card **(e.g. at least one terminal configured for providing a bingo card with at least one bingo array/matrix).**

(b) suspends the purchase of game cards

(c) after suspending purchasing of game cards generates numbers to obtain a sequence of calls **(e.g. provides a sequence of drawn bingo numbers).**

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(d) applies the sequence of calls to each purchased game card and identifies the at least one winning game card **(e.g. predetermines the sequence of calls including the winning drawn numbers and determines the winner)**.

(e) after step (d), **the server transmits/presents the sequence of calls applied in step (d) (e.g. sequence including a winning sequence) to each remote client which has been used to purchase the at least one game card.**

(f) the server on each game client repeats the sequence of calls applied in step(d) until the at least one winning game card is identified or declared.

Malone discloses that the numbers may be applied to the cards as they are generated until the winning card or cards are determined, which is a clear interpretation that the transmitted sequence of calls to the remote clients is respective of the winning sequence of drawn bingo numbers (Abstract, Col. 2:1-27, Col. 4:43-45, Figs. 4-6, (Array/matrix bingo cards-Col. 1:10-21)).

The bingo server includes a random number generator for generating a random sequence of calls. The bingo server further includes a call application module (ticket validation module) and winning card identification module for applying the sequence of calls to the purchased game cards stored in the server and identifying at least one winning card **e.g. a ticket validation module configured for comparing the sequence of drawn bingo numbers to bingo numbers of each bingo card to determine at least one ticket and a winning sequence of drawn bingo numbers** (Col. 5:60-Col. 6:4, see *ID*).

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Malone discloses the above, but fails to teach at least one gaming terminal configured to dispense bingo tickets to players. Malone clearly discloses that players can purchase bingo cards via remote game computers (abstract). In an analogous reference, Itkis et al discloses a promotional bingo game system wherein players can receive paper bingo cards via kiosks and electronic bingo cards via electronic terminals (Abstract, ¶19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bingo gaming system of Malone with the bingo card dispenser of Itkis for purposes of providing players another way to participate in a bingo game. The players that have access to electronic units can participate and check their cards via the electronic unit and players without such access can track progress of the game or play the game via the paper card/ticket.

Malone in view of Itkis teaches the above, but lacks explicitly disclosing presenting the sequence of drawn numbers via an animated drawing subsystem including a video library for generating/compiling video segments respective of drawn numbers including winning numbers into a bingo game video. In a further analogous reference, Graves teaches an animated drawing subsystem that comprises pre-recorded video clips that can take the form of a live ball caller or person (live ball caller or person limitation - Claims 21 & 25) that draws and announces bingo numbers or it can take the form of an animated character performing the same function (Spec: Col. 4:21-40). Graves teaches that as the bingo game events occur the host computer/server transmits data and code related to the respective pre-recorded clips,

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which are stored at the remote terminals; and the remote terminals use the codes to compile a video representation of the bingo game events (Col. 6:33-44).

Graves furthermore teaches that the invention is intended to enhance entertainment value of game presentations by the seamless insertion of animation and entertaining graphics into the presentation of game events, which is interpreted to mean that even though each number is drawn at a time the video segments are displayed in a seamless sequence e.g. a compiled video (Col. 3:39-43). Graves teaches that the presentation is somewhat delayed as well (Col. 3:44-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bingo system of Malone in view of Itkis to include the animation drawing subsystem of Graves to provide a more simulated or realistic bingo environment to the player. Malone discloses that the invention is drawn toward giving the appearance of a bingo game in real time (Col. 6:15-20, Col. 7:5-10) e.g. the winner card is determined prior to actual game play but the player is given the appearance of a game occurring in real time. A visual stimulus, such as Graves's animation subsystem would provide such an appearance to the player by providing a realistic audiovisual representation (Graves - Abstract).

For clarification, in regards to the animation drawing subsystem being on the server side the combination of Malone in view of Itkis and in further view of Graves does not explicitly teach the animation drawing subsystem located at a bingo web server or the host/server side of the network. Particularly, Graves teaches the animation

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subsystem being located on the terminal side. However, Applicant has not disclosed that having the animation subsystem at the server side solves any stated problem or is for any particular purpose. Moreover, it appears that the subsystem of the combination of Malone in view of Itkis and in further view of Graves, or the Appellant's invention, would perform equally well with the animation subsystem at either location **because both provide the same function of providing a video representation of a game to remote players**. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of Malone in view of Itkis and in further view of Graves such that the animation subsystem is located at the server-side of the network because such a modification would have been considered a mere design consideration which fails to patentably distinguish itself over the combination of Malone in view of Itkis and in further view of Graves (The above rationale is a reiteration of office action filed 01/17/08 (page 3), and argumentative response filed 10/01/08 (pages 7-8)).

Claims 22 and 26-27: Each of the references applied above teach at least each bingo card including a unique card identifier for purposes of card validation and/or determining a winner. Malone discloses that purchased cards, including identifying information, are stored in a storage device within the server (Col. 5:55-56). The system further includes a call application module (ticket validation module) and winning card identification module for applying the sequence of calls to the purchased game cards stored in the server and identifying at least one winning card (Col. 5:60-Col. 6:4). Itkis teaches that each bingo ticket has a corresponding ticket identifier (Abstract, Fig. 2). Graves

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teaches that each ticket is stored and has a corresponding ticket identifier (Col. 5:44-59).

Claims 23 and 28: Each of the references applied above refer to the bingo game as playable on the internet. Furthermore, Itkis teaches that bingo games are known in the art as playable on the Internet sites (§ 1). This allows multiple players to participate in the bingo game by allowing players to participate from remote locations. Therefore, it would have been obvious to one of ordinary skill in the art to modify the bingo game, as taught above, to be published or playable on internet sites in order to allow multiple players to participate in the bingo game by allowing players to participate from remote locations in the comfort and convenience of their own home.

(10) Response to Argument

APPELLANT ARGUES CLAIMS 20-28 ARE ALLEGEDLY PATENTABLE UNDER 35 U.S.C. § 103.

Appellant argues Malone allegedly “fails to disclose an animated drawing subsystem including a video library generating/compiling video segments respective of drawn numbers including winning numbers into a video bingo game.” The Examiner asserts Graves teaches the claimed feature. Appellant, then argues that Graves fails to teach “i) a bingo game video compiled from video segments corresponding to the winning sequence, ii) that those video segments are stored in a library of a bingo game generator located on a server, iii) that those segments are retrieved according to a winning sequence of drawn bingo numbers provided by the bingo game generator, and

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iv) transmitting from the server the bingo game video compiled from individual segments.”

In response the Examiner agrees that Graves’s **gaming machine** retrieves segments one at a time corresponding to a drawn number, but also that **the video segments** or graphics **are displayed in a seamless presentation** as noted in the rejection above. Consequently the seamless sequence presented by Graves implies a compiled bingo video. Furthermore, Column 7, lines 45-65 disclose a sequence of steps, in which one step states "**video clip**: Call Balls" which indicates a clip of compiled video call segments, which indicates at least one bingo video with a sequence of drawn bingo calls. The Examiner admits Graves discloses the following:

“as each number is received by a client computer at a remote location, a stored video clip is played showing the drawing of that number. Whenever a player at a remote location claims to have a winning card, a game director, upon receiving notification of this event, stops the ball call sequence until the win can be verified as described above.”

However, the Examiner interprets the above to be indicative of a pause in the overall bingo game video, and that Graves’s bingo game video is an overall seamless presentation of combined/compiled video segments or called balls (Column 7:44-65). The Examiner asserts Appellant is giving the "a bingo game video" claimed feature more weight than is being claimed. Appellant further discloses that Graves fails to teach retrieving video segments corresponding to a winning sequence of drawn numbers; however a reasonable interpretation of Appellant’s Claims 20 and 24 the

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entire displayed sequence of drawn balls inherently would encompass the winning sequence of drawn balls. Furthermore, Malone teaches a bingo game server or game generator that implements the following steps:

(a) providing a plurality of unique game cards and enabling players to purchase the cards via remote game client computers/terminals, wherein at least one game is a winning card **(e.g. at least one terminal configured for providing a bingo card with at least one bingo array/matrix).**

(b) suspends the purchase of game cards

(c) after suspending purchasing of game cards generates numbers to obtain a sequence of calls **(e.g. provides a sequence of drawn bingo numbers).**

(d) applies the sequence of calls to each purchased game card and identifies the at least one winning game card **(e.g. predetermines the sequence of calls including the winning drawn numbers and determines the winner).**

(e) after step (d), **the server transmits/presents the sequence of calls applied in step (d) (e.g. sequence including a winning sequence) to each remote client which has been used to purchase the at least one game card.**

(f) the server on each game client repeats the sequence of calls applied in step(d) until the at least one winning game card is identified or declared.

Malone discloses that the numbers may be applied to the cards as they are generated until the winning card or cards are determined, which is a clear interpretation that the transmitted sequence of calls to the remote clients is respective of the winning

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sequence of drawn bingo numbers (Abstract, Col. 2:1-27, Col. 4:43-45, Figs. 4-6, (Array/matrix bingo cards-Col. 1:10-21)).

The bingo server includes a random number generator for generating a random sequence of calls. The bingo server further includes a call application module (ticket validation module) and winning card identification module for applying the sequence of calls to the purchased game cards stored in the server and identifying at least one winning card **e.g. a ticket validation module configured for comparing the sequence of drawn bingo numbers to bingo numbers of each bingo card to determine at least one ticket and a winning sequence of drawn bingo numbers** (Col. 5:60-Col. 6:4, see *ID*).

In summary, Malone discloses a bingo game server or generator that generates a sequence of drawn bingo calls/numbers including the winning sequence of drawn numbers to generate an already predetermined bingo game. In combination, Malone in view of Graves teaches a bingo server including a bingo generation means (Malone) that provide a bingo video compiled of video segments (Graves) corresponding to a sequence of winning drawn bingo numbers wherein the server at least generates the winning sequence of drawn numbers (Malone) and signals to the animation subsystem (Graves) of the remote terminals which video segments to compile into a bingo game video based on the above.

Turning to the claim feature directed to the animation subsystem located on the server side, the Examiner concedes that Malone in view of Itkis and in further view of Graves does not explicitly teach that the animation drawing subsystem is located at a

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bingo web server or the host/server side of the network. Instead, Graves teaches the animation subsystem is located on the terminal side.

However, although Appellant argues on pages 13-14 that such a feature is integral to the claimed invention, Appellant lacks disclosing within the specification that having the animation subsystem at the server side solves any stated problem or is for any particular purpose. Moreover, it appears that the subsystem of Malone in view of Itkis and in further view of Graves would perform equally well as Appellant's invention with the animation subsystem at either location **because both provide the same function of providing a video representation of a game to remote players.**

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Malone in view of Itkis and in further view of Graves such that the animation subsystem such is located at the server-side of the network because such a modification would have been considered a mere design consideration which fails to patentably distinguish itself over Malone in view of Itkis and in further view of Graves.

APPELLANT ALLEGS CLAIMS 20-28 ARE PATENTABLE UNDER 35 U.S.C. § 103(A) BECAUSE THE REFERENCES PURPORTEDLY TEACH AWAY FROM THE COMBINATION.

The Appellant argues that it is improper to at least combine the references of Malone and Graves. Appellant argues that Grave explicitly teaches that the interaction of players should be incorporated into the presentation of game events and that Malone

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teaches that a player is not required to actively participate in a live bingo game. Thus, the Appellant alleges that it would defeat the purpose of Malone to incorporate the interaction of players into the presentation of game events as required by Graves.

The Examiner respectfully disagrees with the above rationale. Malone is intended to provide a game where the bingo game appears to be provided in real time e.g. even though the outcome and sequence is already determined the game should still appear real. Consequently, interaction by the player would be deemed appropriate. However, Malone does disclose indications of player interaction. Malone discloses that the player can mark the called balls automatically or manually and can furthermore mark cards incorrectly (Col. 6:59-Col. 7:37). A player can erroneously declare a false winning card that is just not validated by the system e.g. player can still declare winning cards (See *ID*). This is a clear indication of player interaction that is intended to provide the appearance of a real-time bingo game. As such the combination of at least Malone in view of Graves is deemed proper by the Examiner.

APPELLANT ALLEGES CLAIMS 20-28 ARE PATENTABLE UNDER 35 U.S.C. § 103(A) BECAUSE THE REFERENCES PURPORTEDLY TEACH AWAY FROM THE CLAIMED INVENTION.

Appellant argues that Graves teaches away from the claimed invention. Specifically, Appellant alleges Graves teaches away from “the transmission of a bingo video compiled from video segments corresponding to a winning sequence of drawn numbers.” The Appellant interprets Graves to disclose that “increased band width

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required for transmitting still pictures or video of an actual game event results in often unacceptable increases in system cost and complexity." Moreover, Appellant argues that Graves's invention is intended to employ low band width telecommunications to provide realistic entertainment video presentations and take advantage of low cost and high speed operations available on personal computers having large hard disk and random access memory.

The Examiner respectfully disagrees and asserts **Graves never explicitly discloses that video clips should be stored on the remote location and not at the central computer so as to avoid transmission of the video or still shots.**

Specifically, Graves merely teaches an invention intended to employ low band width telecommunications to provide realistic entertainment video presentations and take advantage of low cost and high speed operations available on personal computers having large hard disk and random access memory. Furthermore, Graves teaches that "with increased bandwidth, still pictures, and with a full T1 connection or satellite link to each remote site, compressed video of the actual game event can be provided," **which is an indication that sending video representative of a game from a central site to remote sites is well known in the art.**

The Federal Circuit held, "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) e.g. simply because Graves discloses that with increased bandwidth, transmission of video of actual game events to remote sites can be provided and that

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increased bandwidth also means often unacceptable increases in system cost and complexity does not make the known or obvious variant (animation drawing subsystem or video clip system/storage at the web/host server side) patentable simply because it has been described as somewhat inferior to some other variant (video clip system/storage at remote terminal) for the same use and as such does not teach away from the claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tramar Harper/ Patent Examiner Technology Center 3700

Conferees:

/Scott Jones/ Primary Patent Examiner Technology Center 3700

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